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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,106	07/14/2003	Sylvie Andraud	28944/40073	5802

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EXAMINER

GERGISO, TECHANE

ART UNIT PAPER NUMBER

2137

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/619,106	Applicant(s) ANDRAUD ET AL.	
	Examiner Techane J. Gergiso <i>T-G</i>	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/14/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/15/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8 have been examined.
2. Claims 1-8 are pending.

Drawings

3. The drawings are objected to because the disclosure refers parts of figure 2 as step of actions of functions to be carried out in the system. For example: page 5, lines 17: an initialization step 20 is activated and page 5, lines 25: in step 22, the microprocessor 15 calculates a cryptogram on the data of the transaction. However, the layout and interconnection of parts in figure 2 is not clear to set forth the steps or at least the flow of steps.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The abstract of the disclosure is objected to because typo "Figure 2" is improper in the last line of the abstract page and the underlined title is improper in the abstract page. Correction is required. See MPEP § 608.01(b).

6. Applicant is reminded of the proper language and format for an abstract of the disclosure. Improper claim languages are used in the abstract. Fore example, " the method comprises steps in which."

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The examiner objects the arrangements of the specification.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

8. Claims 1 and 5 are objected to because of the following informalities:

In (page 8, lines 6-7) the phrase "Comprising steps wherein:" is not clear.

The examiner suggests "comprising the steps of:."

In page (page 8: line 29) the phrase "devices so as :" is not clear.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "as soon as " in claims 1 and 5 are a relative term which renders the claim indefinite. The term " as soon as" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Proper correction is required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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12. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoshino et al. (hereinafter referred to as Hoshino, US Pub No.: 2002/0111918 A1).

As per claim 1:

Hoshino discloses a method of generating a tangible element of proof which guarantees that a specified transaction has been carried out using a specified microcircuit card, the microcircuit of the said card comprising a microprocessor and an internal memory, comprising steps wherein (page 11: 0166-0169; page 12:0170-174):

the microprocessor records, in the internal memory, a cryptogram on the data of the transaction, as soon as it detects a confirming event for validating the transaction

(page 2: 022-0028; page 3: 0034-0036; figure 4: 33-35; figure 5:42-48;

the microprocessor transmits a transaction validation signal out of the card, after having

recorded the cryptogram in the internal memory (page 9: 0141-0143; page 12:

0177; figure 13: S1204-S1209, S1210-S1214).

As per claim 2:

Hoshino discloses a method, wherein the said confirming event results from a comparison performed by the microprocessor which verifies that a code received is equal to a secret code held in the internal memory (figure 13: S1206).

As per claim 3:

Hoshino discloses a method, wherein the data of the transaction comprise a date and a monetary amount (page 8: 0117; figure 5:42).

AS per claim 4:

Hoshino discloses a method, wherein the data of the transaction comprise a transaction destination identifier (page 17: 0228).

As per claim 5:

Hoshino discloses a microcircuit card comprising a microprocessor and an internal memory for performing transactions with a terminal, wherein the internal memory contains a microprogram executable by the microprocessor of the microcircuit and devised so as (page 11: 0166-0169; page 12:0170-174):

to record, in the internal memory, a cryptogram on data of each transaction, when
detecting a confirming event for validating the transaction (page 2: 022-0028;
page 3: 0034-0036; figure 4: 33-35; figure 5:42-48;

to transmit a transaction validation signal out of the card, after having recorded the
cryptogram in the internal memory (page 9: 0141-0143; page 12: 0177; figure 13:
S1204-S1209, S1210-S1214).

As per claim 6:

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Hoshino discloses a microcircuit card, wherein the microprogram is devised to perform a comparison from which the said confirming event results when a code received is equal to a secret code held in the internal memory (figure 13:s1206).

As per claim 7:

Hoshino discloses a microcircuit card, wherein the microprogram is devised to receive the data of the transaction which comprise a date and a monetary amount (page 8: 0117; figure 5:42).

As per claim 8:

Hoshino discloses a microcircuit card, wherein the microprogram is devised to receive the data of the transaction which comprise a transaction destination identifier (page 17: 0228).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See the notice of reference cited in form PTO-892 for additional prior art

Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is (571) 273-3784. The examiner can normally be reached on 9:00am - 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T-G

Techane Gergiso

Patent Examiner

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October 12, 2006


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER